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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,053	12/29/2000	Daniel W. Gil	D2919	8979

33197 7590 09/30/2003

STOUT, UXA, BUYAN & MULLINS LLP  
4 VENTURE, SUITE 300  
IRVINE, CA 92618

EXAMINER

RILEY, JEZIA

ART UNIT	PAPER NUMBER
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1637

18

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/751,053

Applicant(s)

GIL ET AL.

Examiner

Jezia Riley

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21,23-28,30-44 and 68-71 is/are pending in the application.
- 4a) Of the above claim(s) 18-21,23,24 and 35 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 70 and 71 is/are allowed.
- 6) ☒ Claim(s) 1-17,25,26,30-34,36-44,68 and 69 is/are rejected.
- 7) ☒ Claim(s) 27 and 28 is/are objected to.
- 8) ☒ Claim(s) 1-21,23-28,30-44 and 68-71 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Remarks***

1. Applicants' arguments and amendments, filed on 7/18/03, have been approved and entered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-17, 25, 26, 30-34, 36-44, 68, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinshank et al. (5,595,880) in view of Dolly et al. (WO 95/32738).

Weinshank discloses DNA encoding a  $\alpha$ 2B adrenergic receptor and uses thereof. The reference discloses a method for determining whether a ligand which is not known to be capable of binding to the .alpha.2b.2B -adrenergic receptor can bind to the .alpha..2B -adrenergic receptor on the surface of a cell, and a method of screening drugs to identify drugs to identify drugs which specifically interact with, and bind to, the .alpha.2B -adrenergic receptor. A method of screening drugs to identify drugs which specifically interact with, and bind to, the .alpha..2B -adrenergic receptor on the surface of a cell is therefore disclosed. This method comprises contacting a mammalian cell which is expressing.alpha..2B -adrenergic receptor with a plurality of drugs, known or putative, determining those drugs which bind to the mammalian cell, and thereby identifying drugs which specifically interact with, and bind to, the .alpha..2B -adrenergic receptor.

Dolly et al. (WO 95/32738) discloses chemical conjugate for treating a nerve cell related disorder. (pages 6-18). This conjugate includes an active or inactive botulinum or tetanus having a specificity for a target nerve cell. The toxin is conjugated to a drug or other bioactive molecule without affecting the toxin's ability to enter the target nerve cell. (Page 2).

Therefore it would have been obvious at the time the invention was made to apply the conjugate of Dolly et al. for the method of screening drugs of the method of Weinshank et al. The motivation is that the conjugate of Dolly et al. is a reconstituted toxin, having an inactivated L chain disulfide -bonded to a native H chain, which retained the ability to specifically interact with target receptors and become transported

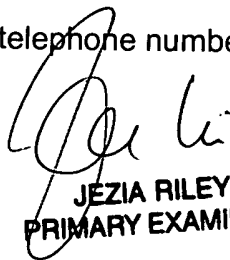
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to the cytosol, together with the attached molecule. (page 6) Hence the inactivated and chemically modified toxin complex can be used as a system for delivering linked chemical compounds to the cytosol of neuronal cells that express cell surface receptors for the toxins. (Page 7).

4. Claims 27 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claims 70-71 are allowed.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jezia Riley whose telephone number is 703-305-6855. The examiner can normally be reached on 9:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
JEZIA RILEY  
PRIMARY EXAMINER

9/21/03